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HEWLETT-PACKARD COMPANY  
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10003357-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David D. Bohn

Confirmation No.: 6278

Application No.: 09/900,211

Examiner: J. T. Nguyen

Filing Date: July 6, 2001

Group Art Unit: 2674

Title: METHOD AND APPARATUS FOR INDICATING AN OPERATING MODE FOR A COMPUTER POINTING DEVICE

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 3, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month  
\$120

☐ 2nd Month  
\$450

☐ 3rd Month  
\$1020

☐ 4th Month  
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

David D. Bohn

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Docket No.: 10003357-1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
David D. Bohn

Application No.: 09/900,211

Confirmation No.: 6278

Filed: July 6, 2001

Art Unit: 2674

For: METHOD AND APPARATUS FOR  
INDICATING AN OPERATING MODE FOR A  
COMPUTER POINTING DEVICE

Examiner: J. T. Nguyen

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on January 3, 2006, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument

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- IX. Evidence Appendix
- X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Limited Partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 19 claims pending in the application.

B. Current Status of Claims

1. Claims canceled: 5
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-4 and 6-21
4. Claims allowed: None
5. Claims rejected: 1-4, 6, 8-21
6. Claims objected to: 7.

C.  
Claims On Appeal

The claims on appeal are claims 1-4, 6, 8-21

IV. STATUS OF AMENDMENTS

The present application was filed July 6, 2001. In response to an Office Action mailed December 16, 2003, Applicant filed a Request for Continued Examination on March 11, 2004. In response to an Office Action mailed September 2, 2004, Applicant submitted an Amendment on December 2, 2004. A Final Office Action was then mailed April 19, 2005. In response to such Final Office Action, Applicant filed a notice of appeal (on June 10, 2005) with a supporting Appeal Brief (filed August 10, 2005). Thus, no amendments were made after the April 19, 2005 Final Office Action, and the claims on appeal were as rejected in the Final Office Action.

In response to the August 10, 2005 Appeal Brief, the Examiner did not submit an Answer but instead reopened prosecution with new grounds of rejection in an Office Action mailed November 2, 2005. In response, Applicant filed a notice of appeal (mailed January 3, 2006), which this Appeal Brief supports. Accordingly, the claims on appeal are those as rejected in the April 19, 2005 Office Action and again rejected on new grounds in the November 2, 2005 Office Action. A complete listing of the claims is provided in the Claims Appendix hereto.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

According to one claimed embodiment, such as that of claim 1, a computer-pointing device (12 of Figure 1) comprises a first illumination apparatus (20 of Figure 1) operatively

associated with the computer-pointing device, said first illumination apparatus generating light when the computer-pointing device is in a standby mode (page 1, lines 17-25), the light generated by said first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device (page 3, lines 8-10, and page 4, lines 30-32), and a second illumination apparatus (26 of Figure 1) operatively associated with the computer-pointing device, said second illumination apparatus generating light when the computer-pointing device is in an input operating mode (page 8, lines 22-32), the light generated by said second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device (page 3, lines 8-10, and page 4, lines 30-32).

According to one claimed embodiment, such as that of claim 8, the computer-pointing device further comprises a switch, said switch allowing the user to disable the first illumination apparatus and the second illumination apparatus (page 12, lines 13-16).

According to another claimed embodiment, such as that of claim 18, a method comprises providing a computer-pointing device with a first illumination apparatus and a second illumination apparatus (page 7, lines 24-26, and page 8, lines 22-24), determining whether the computer-pointing device is in a standby mode (62 of Figure 4, 166 of Figure 7, page 12, lines 17-23), illuminating said first illumination apparatus if it is determined that the computer-pointing device is in the standby mode (page 12, lines 21-23), the illumination of the first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device (page 3, lines 8-10, and page 4, lines 30-32), determining whether the computer-pointing device is in an input operating mode (62 of Figure 4, 166 of Figure 7, page 12, lines 17-23), and illuminating said second illumination apparatus if it is determined that the computer-pointing device is in the input operating mode (page 12, lines 20-21), the illumination of the second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device (page 3, lines 8-10, and page 4, lines 30-32).

According to another claimed embodiment, such as that of claim 20, a computer-pointing device comprises means for providing for a user a first visual indication that the computer-pointing device is in a standby mode (e.g., 22 of Figure 1 and 52, 56, 58 of Figure

3, and page 9, lines 20-33, page 11, lines 3-7, and page 12, lines 17-23) and means for providing the user a second visual indication that the computer-pointing device is in input operating mode (e.g., 32 and 34 of Figure 1 and 52, 56, 58 of Figure 3, and page 9, lines 20-33, page 11, lines 3-7, and page 12, lines 17-23).

According to another claimed embodiment, such as that of claim 21, a computer-pointing device, comprises a cursor movement control device (12 of Figure 1), said cursor movement control device allowing a user to move a cursor on display apparatus operatively associated with the computer-pointing device, a first illumination apparatus, said first illumination apparatus generating light when the computer-pointing device is in a standby mode (20 of Figure 1 and page 12, lines 21-23), the light generated by said first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device (page 3, lines 8-10), and a second illumination apparatus, said second illumination apparatus generating light when the computer-pointing device is in an input operating mode (26 of Figure 1 and page 12, lines 20-21), the light generated by said second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device (page 3, lines 8-10).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claim 20 is rejected under 35 U.S.C. §102(b) as being anticipated over U.S. Patent No. 5,734,372 (hereinafter, *Verstockt*).
- B. Claims 1-4, 15-18, and 21 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of U.S. Patent No. 6,623,194 (hereinafter, *Lip*).
- C. Claims 6 and 19 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of U.S. Patent No. 5,841,425 (hereinafter, *Zenz*).
- D. Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of U.S. Patent No. 5,998,751 (hereinafter, *Brunelle*).
- E. Claim 9 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of U.S. Patent No. 3,938,138 (hereinafter, *Kojima*).

F. Claims 10, 11, 13, and 14 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of U.S. Patent No. 6,559,830 (hereinafter, *Hinckley*).

G. Claim 12 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of U.S. Patent No. 6,650,322 (hereinafter, *Dai*).

## VII. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board reverse the outstanding rejections in light of the remarks contained herein. The claims do not stand or fall together. Instead, Appellant presents separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

### A. Rejection under 35 U.S.C. §102(b) over *Verstockt*

#### Independent Claim 20

On pages 2-3, the November 2, 2005 Office Action rejects claim 20 under 35 U.S.C. §102 as being anticipated by *Verstockt*. To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. Thus, § 102 anticipation is not found when the prior art is lacking or missing a specific feature or the structure of the claimed invention. *See* M.P.E.P. § 2131. Further, Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. Appellant respectfully submits that claim 20 is not anticipated under § 102 by *Verstockt* because *Verstockt* fails to teach each and every element of claim 20, as discussed below.

Claim 20 recites a computer-pointing device comprising: “means for providing for a user a first visual indication that the computer-pointing device is in a standby mode; and means for providing the user a second visual indication that the computer-pointing device is in input operating mode.” *Verstockt* fails to teach such a visual indication of standby mode and input operating mode of a computer-pointing device.

*Verstockt* teaches a system that monitors a computer user's mouse use. *Verstockt* at Col. 2, lines 54-64. Once the mouse use exceeds a predetermined threshold, Light Emitting Diodes (LEDs) on the mouse alert the user to take a break, thereby preventing discomfort and fatigue of the user's hand. *Id.* at Col. 2, line 64 through Col. 3, line 5 and Col. 3, lines 14-33. Specifically, *Verstockt* teaches monitoring continuous operation of the mouse and alerting the user to the amount of use. See *Id.* Thus, the operation status that *Verstockt* teaches as indicated by the LEDS is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See *Id.* Such cumulative operation and movement does not constitute a "standby mode" or "input operating mode", as recited by claim 20.

*Verstockt* does not provide any visual indication that its mouse is in a standby mode, input operating mode, or any other mode. The operation status that *Verstockt* teaches is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See *Verstockt* at Col. 2, line 54 through Col. 3, line 5. This cumulative operation status is used to determine when it is appropriate for a user to take a rest. See *Verstockt* at Col. 3, lines 14-17. Cumulative operation and movement does not constitute a standby mode or any other mode. For instance, the mouse in *Verstockt* may be in operational mode for some period of time before the LED lights to indicate to the user that it is time to take a rest. Accordingly, when a user first begins using the mouse the LED is not lit, although the mouse is in an input operating mode. After the mouse is moved some cumulative time or distance, the LED may light to indicate that the user should take a rest. Thus, the LED of *Verstockt* does not provide a visual indication of whether the mouse is in a standby mode or in an input operating mode, as the LED may be off when the mouse is in an input operating mode or the LED may be on when the mouse is in such input operating mode. The LED of *Verstockt* is indicative of whether the user should take a rest, and is not indicative of the mode of the mouse.

The November 2, 2005 Office Action asserts at page 9 thereof:

*Verstockt* teaches a light emitting diodes LED 33 operatively associated with a mouse, said LED 33 is visible when the mouse is in operation or being used by the user. In other words when the mouse in [sic] not being used by the user, the LED 33 is not visible (col. 3, lines 23-42).



The Examiner appears to be misreading the teaching of col. 3, lines 23-42 as teaching that the LED 33 of *Verstockt* is visible when being used by the user and not visible when not being used by the user. This is incorrect. Col. 3, lines 23-42 of *Verstockt* provides:

Please refer to FIG. 2, which is a schematic appearance diagram of a preferred embodiment of a monitor cursor controlling device according to the present invention. It is a computer mouse provided with the function of noticing the operation status to the user, wherein light emitting diodes (LED) 33 are employed as a signaling element and disposed between the frame 31 of the mouse and the click switches 32. When the mouse is in operation, the illuminating status of the LED 33, which are positioned between fingers of the user, is visible.

While the invention has been described in terms of what are presently considered to be the most practical and preferred embodiments, it is to be understood that the invention need not be limited to the disclosed embodiment. On the contrary, it is intended to cover various modifications and similar arrangements included within the spirit and scope of the appended claims which are to be accorded with the broadest interpretation so as to encompass all such modifications and similar structures.

The above teaching of *Verstockt* merely mentions that the LED is positioned on the mouse such that it is visible to a user between the user's fingers when the user's hand is on the mouse. Of course, when the user's hand is not on the mouse the LED remains visible to the user. Thus, the LED does not become invisible when the user is not using the mouse in *Verstockt*.

As discussed above, whether the LED is lit is not an indication of an operating mode of the mouse in *Verstockt*. Instead, the LED being lit merely indicates that the user should take a rest, and is not indicative of the operating mode of the mouse. Further, the LED (whether lit or off) is visible to a user irrespective of whether the user is using the mouse. Therefore, *Verstockt* simply provides no visual indication of a standby mode or of an input operating mode, as recited by claim 20.

In view of the above, *Verstockt* does not teach all elements of claim 20. Accordingly, Appellant respectfully requests reversal of the rejection of claim 20.

**B. Rejections under 35 U.S.C. §103 over *Verstockt* in view of *Lip***

Claims 1-4, 15-18, and 21 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip*. Appellant traverses the rejections.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. *See In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck and Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Without conceding the first and second criteria, Appellant asserts that the Examiner's rejection of these claims does not satisfy the third criterion.

**Independent Claim 1 and Dependent Claims 2-4 and 15-17**

Independent claim 1 recites, in part, "said first illumination apparatus generating light when the computer-pointing device is in a standby mode." The cited combination does not teach or suggest at least this feature of claim 1 because neither *Verstockt* nor *Lip* teach or suggest generating light when a computer-pointing device is in a standby mode.

First, *Verstockt* does not teach or suggest the above-mentioned feature. As discussed above with claim 20, *Verstockt* does not teach or suggest that its LED illuminates to indicate a standby mode, or any other mode for that matter. The illumination of its LED depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. *See Verstockt* at Col. 2, line 54 through Col. 3, line 5. The LED being on merely indicates when it is appropriate for a user to take a rest (*See Verstockt* at Col. 3, lines 14-17), and does not indicate a standby mode of the mouse. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 1.

Second, *Lip* also does not teach or suggest the above-mentioned feature because *Lip* does not teach or suggest a standby mode of a computer-pointing device. Col. 14, lines 17-25 of *Lip* provides:

Mouse boards 502 and 503 may be operated in either keyboard or mouse mode. Basically, when the board is moved, it functions as a computer mouse. And when the board is resting still and touching any of the boundaries of its base mouse station, the board functions as a computer keyboard. There are other rules to control the mode, and there is a mode button on each of the mouse boards to change the mode explicitly.

Col. 20, lines 31-38 of *Lip* further provides:

There are visual indicators 544 and 545 located on mouse boards 502 and 503 respectively to indicate visually the mode of the mouse boards. For example, the indicator may change its colour to green when the corresponding mouse board is in keyboard mode. And it may change its colour to yellow when the corresponding mouse board is in mouse mode.

Thus, *Lip* teaches that its mouse boards may be placed into either a mouse mode or a keyboard mode. When in keyboard mode, visual indicator 544, 545 may be green, and when in mouse mode, the visual indicator 544, 545 may change its color to yellow. However, neither yellow nor green color of the visual indicator 544, 545 indicates a standby mode of the mouse boards in *Lip*. For instance, if placed in keyboard mode, the indicator is green, irrespective of whether the keyboard is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Similarly, if placed in mouse mode, the indicator is yellow, irrespective of whether the mouse is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Thus, visual indicators 544, 545 are not indicative of whether the mouse boards are in a standby mode or in an input operating mode, such as recited by claim 1.

In view of the above, the cited combination of *Verstockt* and *Lip* does not teach or suggest at least the above-recited element of claim 1. Accordingly, Appellant respectfully requests that the rejection of claim 1 be overturned.

Dependent claims 2-4 and 15-17 each depend either directly or indirectly from independent claim 1 and, thus, include all of the limitations of independent claim 1 in addition to their own supplied limitations. Thus, the cited combination does not teach or suggest all claim limitations of claims 2-4 and 15-17. It is respectfully submitted that dependent claims 2-4 and 15-17 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claims 2-4 and 15-17.

Independent Claim 18

Independent claim 18 recites, in part, “illuminating said first illumination apparatus if it is determined that the computer-pointing device is in the standby mode.” The cited combination of *Verstockt* and *Lip* fails to teach or suggest at least this feature of claim 18.

First, as explained above with regard to claim 1, *Verstockt* does not teach or suggest the above-mentioned feature. *Verstockt* does not teach or suggest that its LED illuminates to indicate a standby mode, or any other mode for that matter. The illumination of its LED depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See *Verstockt* at Col. 2, line 54 through Col. 3, line 5. The LED being on merely indicates when it is appropriate for a user to take a rest (See *Verstockt* at Col. 3, lines 14-17), and does not indicate a standby mode of the mouse. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 18.

Second, *Lip* also fails to teach or suggest the above-mentioned feature because *Lip* does not teach or suggest a standby mode of a computer-pointing device. As discussed above with claim 1, *Lip* teaches that its mouse boards may be placed into either a mouse mode or a keyboard mode. When in keyboard mode, visual indicator 544, 545 may be green, and when in mouse mode, the visual indicator 544, 545 may change its color to yellow. However, neither yellow nor green color of the visual indicator 544, 545 indicates a standby mode of the mouse boards in *Lip*. For instance, if placed in keyboard mode, the indicator is green, irrespective of whether the keyboard is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Similarly, if placed in mouse mode, the indicator is yellow, irrespective of whether the mouse is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Thus, visual indicators 544, 545 are not indicative of whether the mouse boards are in a standby mode or in an input operating mode, such as recited by claim 18.

In view of the above, the cited combination of *Verstockt* and *Lip* does not teach or suggest at least the above-recited element of claim 18. Accordingly, Appellant respectfully requests that the rejection of claim 18 be overturned.

Independent Claim 21

Independent claim 21 recites, in part, “said first illumination apparatus generating light when the computer-pointing device is in a standby mode.” The cited combination of *Verstockt* and *Lip* fails to teach or suggest at least this feature of claim 21.

First, as explained above with regard to claim 1, *Verstockt* does not teach or suggest the above-mentioned feature. *Verstockt* does not teach or suggest that its LED illuminates to indicate a standby mode, or any other mode for that matter. The illumination of its LED depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See *Verstockt* at Col. 2, line 54 through Col. 3, line 5. The LED being on merely indicates when it is appropriate for a user to take a rest (See *Verstockt* at Col. 3, lines 14-17), and does not indicate a standby mode of the mouse. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 21.

Second, *Lip* also fails to teach or suggest the above-mentioned feature because *Lip* does not teach or suggest a standby mode of a computer-pointing device. As discussed above with claim 1, *Lip* teaches that its mouse boards may be placed into either a mouse mode or a keyboard mode. When in keyboard mode, visual indicator 544, 545 may be green, and when in mouse mode, the visual indicator 544, 545 may change its color to yellow. However, neither yellow nor green color of the visual indicator 544, 545 indicates a standby mode of the mouse boards in *Lip*. For instance, if placed in keyboard mode, the indicator is green, irrespective of whether the keyboard is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Similarly, if placed in mouse mode, the indicator is yellow, irrespective of whether the mouse is in an input operating mode or a standby mode (e.g., irrespective of whether it is being used by the user). Thus, visual indicators 544, 545 are not indicative of whether the mouse boards are in a standby mode or in an input operating mode, such as recited by claim 21.

In view of the above, the cited combination of *Verstockt* and *Lip* does not teach or suggest at least the above-recited element of claim 21. Accordingly, Appellant respectfully requests that the rejection of claim 21 be overturned.

**C. Rejections under 35 U.S.C. §103 over *Verstockt* in view of *Lip* and *Zenz***

Claims 6 and 19 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of *Zenz*. Appellant respectfully traverses these rejections.

**Claim 6**

Dependent claim 6 depends from independent claim 1 and, thus, includes all of the limitations of independent claim 1 in addition to its own supplied limitations. It is respectfully submitted that dependent claim 6 is allowable at least because of its dependence from claim 1 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claim 6.

**Claim 19**

Dependent claim 19 depends from independent claim 18 and, thus, includes all of the limitations of independent claim 18 in addition to its own supplied limitations. It is respectfully submitted that dependent claim 19 is allowable at least because of its dependence from claim 18 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claim 19.

**D. Rejection under 35 U.S.C. §103 over *Verstockt* in view of *Lip* and *Brunelle***

Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of *Brunelle*. Appellant respectfully traverses this rejection.

**Claim 8**

Claim 8 recites, in part, “said switch allowing the user to disable the first illumination apparatus and the second illumination apparatus.” Appellant respectfully submits that insufficient motivation exists for one of ordinary skill in the art to modify the device of the primary reference *Verstockt* in the manner suggested by the Office Action. For instance, the November 2, 2005 Office Action concedes that *Verstockt* and *Lip* fail to teach the above element of claim 8, *see* page 6 of the Office Action. However, the Office Action asserts that

*Brunelle* teaches indicator lights 68, 80 that remain illuminated until the user depresses an acknowledgement switch that removes power to the lights (citing to col. 7, lines 15-18 of *Brunelle*), page 6 of the Office Action. The Office Action thus concludes that: “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the switch is depressed by the user as taught by *Brunelle* in the system of the combination of *Verstockt* and *Lip* in order to reduce the power consumption of the device.” Pages 6-7 of the Office Action. Appellant respectfully disagrees, as discussed below.

First, the very operational principle of *Verstockt* is to illuminate an LED to notify a user that it is time to rest. One of ordinary skill in the art would not be motivated to modify *Verstockt* to include a switch for disabling such LED. Note that there is no motivation to disable the illumination apparatus in *Verstockt*, not even to save power, as *Verstockt*'s very principle relies upon the illumination devices to indicate to a user when it is time to rest.

Further, *Brunelle* is directed to non-analogous art from that of *Verstockt* and *Lip*. *Verstockt* and *Lip* are each directed to computer input devices, such as a mouse or keyboard, while *Brunelle* is directed to “a sorting system configured to sort a plurality of components, such as computer chips.” Abstract of *Brunelle*. Indeed, the indicator lights 68, 80 of *Brunelle* illuminate to indicate when a track of the system is filled to capacity with chips that have been sorted.

For instance, *Brunelle* explains: “The chip sorting system 40 includes a component or chip handler 42, which is a device that tests the quality of computer chips and then sorts the chips into groups according to their quality.” *Brunelle* goes on to explain that “the number of indicator lights 68 is equal to the number of tracks 54 in the track area 49 so that each of the indicator lights 68 has an associated track 54.” Further, *Brunelle* explains that:

each bin space 78 has an associated indicator light 80 that is easily identifiable with its associated bin space 78. For example, a bin space 78a on the bin cart 44 has an associated indicator light 80a located immediately above the bin space 78a.

*Brunelle* also provides that:

Once the track 54a is filled to capacity with chips, the corresponding indicator light 68a is illuminated, such as through a switch that is closed when

a predetermined number of chips enter the track 68a. In this manner, the indicator light 68a notifies the person operating the chip handler 42 that the track 54a is filled to capacity. In a similar manner, the other indicator lights on the chip handler 42 also illuminate when their corresponding tracks have been filled to capacity.

And, *Brunelle* explains that:

The corresponding indicator light 80a on the bin cart is also illuminated to notify the operator that the chips from the track 54a should be inserted into the associated bin space 78a. This greatly reduces the likelihood of the operator placing the chips into the wrong bin space 78 and mixing up the chips after they have been sorted by the chip handler 42.

*Brunelle* is not concerned with an input device at all, but is instead concerned with testing and sorting computer chips. Further, *Brunelle*'s lights are used for completely different purposes than those of *Verstockt* or *Lip*. Thus, *Brunelle* is non-analogous art to that of *Verstockt* and *Lip*. One of ordinary skill in the art would not be motivated to look to the teaching of such a disparate reference as *Brunelle* for application in the systems of *Verstockt* and *Lip*.

In view of the above, Appellant respectfully requests reversal of the rejection of claim 8.

**E. Rejection under 35 U.S.C. §103 over *Verstockt* in view of *Lip* and *Kojima***

Claim 9 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of *Kojima*.

**Claim 9**

Dependent claim 9 depends from independent claim 1 and, thus, includes all of the limitations of independent claim 1 in addition to its own supplied limitations. It is respectfully submitted that dependent claim 9 is allowable at least because of its dependence from claim 1 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claim 9.



**F. Rejections under 35 U.S.C. §103 over *Verstockt* in view of *Lip* and *Hinckley***

Claims 10, 11, 13, and 14 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of *Hinckley*. Appellant traverses the rejection.

**Claims 10, 11, 13, and 14**

As shown above, a combination of *Verstockt* and *Lip* does not teach or suggest each and every feature of claim 1. Dependent claims 10, 11, 13, and 14 depend from independent claim 1 and, thus, include all of the limitations of independent claim 1 in addition to their own supplied limitations. The Examiner does not rely on *Hinckley* to cure the deficiency, nor does *Hinckley* cure the deficiency. Thus, the cited combination does not teach or suggest all claim limitations of claims 10, 11, 13, and 14. It is respectfully submitted that dependent claims 10, 11, 13, and 14 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claims 10, 11, 13, and 14.

**G. Rejection under 35 U.S.C. §103 over *Verstockt* in view of *Lip* and *Dai***

Claim 12 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *Lip* and further in view of *Dai*. Appellant traverses the rejection.

**Claim 12**

As shown above, a combination of *Verstockt* and *Lip* does not teach or suggest each and every feature of claim 1. Dependent claim 12 depends from independent claim 1 and, thus, includes all of the limitations of independent claim 1 in addition to its own supplied limitations. The Examiner does not rely on *Dai* to cure the deficiency, nor does *Dai* cure the deficiency. Thus, the cited combination does not teach or suggest all claim limitations of claim 12. It is respectfully submitted that dependent claim 12 is allowable at least because of its dependence from claim 1 for the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of claim 12.

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Date of Deposit: February 10, 2006

Typed Name: Gail L. Miller

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Respectfully submitted,

By: 

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**VIII. CLAIMS APPENDIX**

**Claims Involved in the Appeal of Application Serial No. 09/900,211**

1. A computer-pointing device, comprising:  
a first illumination apparatus operatively associated with the computer-pointing device, said first illumination apparatus generating light when the computer-pointing device is in a standby mode, the light generated by said first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device; and  
a second illumination apparatus operatively associated with the computer-pointing device, said second illumination apparatus generating light when the computer-pointing device is in an input operating mode, the light generated by said second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device.
2. The computer-pointing device of claim 1, wherein the computer-pointing device comprises a mouse.
3. The computer-pointing device of claim 1, wherein said first illumination apparatus comprises a light-emitting diode, and wherein said second illumination apparatus comprises a light-emitting diode.
4. The computer-pointing device of claim 1, wherein said first illumination apparatus generates light having at least one attribute different than the light generated by said second illumination apparatus.
5. (Canceled)
6. The computer-pointing device of claim 1, further comprising a third illumination apparatus operatively associated with the computer-pointing device, said third illumination apparatus generating light when the computer-pointing device is in another mode different from the standby mode and the input operating mode, the light generated by said third illumination apparatus providing for the user a visual indication of another mode of the computer-pointing device.

7. The computer-pointing device of claim 6, wherein said first illumination apparatus generates light when the computer-pointing device is not in contact with the user, wherein said second illumination apparatus generates light when the computer-pointing device is being moved, and wherein said third illumination apparatus generates light when the computer-pointing device is in contact with the user but the computer-pointing device is not being moved.

8. The computer-pointing device of claim 1, further comprising a switch, said switch allowing the user to disable the first illumination apparatus and the second illumination apparatus.

9. The computer-pointing device of claim 1, further comprising a time-delayed shut off switch, said time-delayed shut off switch causing the first illumination apparatus and the second illumination apparatus to be shut off after a period of inactivity.

10. The computer-pointing device of claim 1, further comprising a user detection device operatively associated with the computer-pointing device, said user detection device detecting when the user is accessing the computer-pointing device.

11. The computer-pointing device of claim 10, wherein said user detection device comprises an optical sensor.

12. The computer-pointing device of claim 10, wherein said user detection device comprises a thermal sensor.

13. The computer-pointing device of claim 10, wherein said user detection device comprises a mechanically activated switch.

14. The computer-pointing device of claim 10, wherein said user detection device comprises a capacitance proximity sensor.

15. The computer-pointing device of claim 1, wherein a data processing system is operatively associated with the computer-pointing device, said data processing system receiving a data signal from the computer-pointing device that is indicative of the operating mode of the computer-pointing device, said data processing system processing the data signal so that said first illumination apparatus generates light when the computer-pointing device is in the standby mode and so that said second illumination apparatus generates light when the computer-pointing device is in the input operating mode.

16. The computer-pointing device of claim 1, further comprising a control system, said control system actuating said first illumination apparatus when the computer-pointing device is in the standby mode, said control system actuating said second illumination apparatus when the computer-pointing device is in the input operating mode.

17. The computer-pointing device of claim 1, wherein said first illumination apparatus and said second illumination apparatus comprise a single illumination apparatus.

18. A method, comprising:  
providing a computer-pointing device with a first illumination apparatus and a second illumination apparatus;  
determining whether the computer-pointing device is in a standby mode;  
illuminating said first illumination apparatus if it is determined that the computer-pointing device is in the standby mode, the illumination of the first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device;  
determining whether the computer-pointing device is in an input operating mode; and  
illuminating said second illumination apparatus if it is determined that the computer-pointing device is in the input operating mode, the illumination of the second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device.

19. The method of claim 18, further comprising:  
providing the computer-pointing device with a third illumination apparatus;  
determining whether the computer-pointing device is in another mode that is different from the standby mode and the input operating mode; and  
illuminating said third illumination apparatus if it is determined that the computer-pointing device is in the another mode, the illumination of the third illumination apparatus providing for the user a visual indication of another mode of the computer-pointing device.

20. A computer-pointing device, comprising:  
means for providing for a user a first visual indication that the computer-pointing device is in a standby mode; and  
means for providing the user a second visual indication that the computer-pointing device is in input operating mode.

21. A computer-pointing device, comprising:  
a cursor movement control device, said cursor movement control device allowing a user to move a cursor on display apparatus operatively associated with the computer-pointing device;  
a first illumination apparatus, said first illumination apparatus generating light when the computer-pointing device is in a standby mode, the light generated by said first illumination apparatus providing for a user a visual indication of the standby mode of the computer-pointing device; and  
a second illumination apparatus, said second illumination apparatus generating light when the computer-pointing device is in an input operating mode, the light generated by said second illumination apparatus providing for the user a visual indication of the input operating mode of the computer-pointing device.

**IX. EVIDENCE APPENDIX**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

**X. RELATED PROCEEDINGS APPENDIX**

No related proceedings are referenced in II above, and thus no copies of decisions in related proceedings are provided.